

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BARTHOLOMEW J. FRAZZITTA,  
RANDOLPH C. BENOYE, DANIEL S. McINTYRE,  
MARK A. DePIETRO, and JEFFREY M. KALMAN

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Appeal 2007-0699  
Application 08/889,033<sup>1</sup>  
Technology Center 2600

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Decided: September 21, 2007

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Before LEE E. BARRETT, LANCE LEONARD BARRY, and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 1-44. Claims 45-47 have not been rejected. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We affirm-in-part and enter new grounds of rejection.

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<sup>1</sup> Application for patent filed July 7, 1997, entitled "Transaction System," which is based on and claims priority under 35 U.S.C. § 119(e)(1) from U.S. Provisional Application 60/045,794, filed May 7, 1997.

Appeal 2007-0699  
Application 08/889,033

#### PREVIOUS DECISION

A previous decision was entered in this case, Appeal 2004-1711, on July 21, 2005. The rejections of claims 1-47 were reversed and the application was remanded for consideration of prior art.

#### BACKGROUND

The invention relates to a system for carrying out transactions, which includes a service provider (SP) station operated by a service provider such as a cashier, clerk, or teller, and a customer station operated by a customer requesting a transaction. An example is a bank customer conducting a transaction with a bank teller. Audio and video communications may be conducted between the SP station and the customer station using cameras, displays, microphones, and speakers. Items may be exchanged between customers and the service provider utilizing carriers transmitted through a pneumatic tube system. *See Abstract.* Various claims are directed to the mounting and cover structure of the customer station.

Claim 1 is reproduced below.

1. A transaction system comprising:

a service provider (SP) station, wherein the SP station is enabled to be operated by a service provider providing a transaction, wherein the SP station includes therein an SP carrier delivery and receiving device and at least one component of:

an SP visual display,

Appeal 2007-0699  
Application 08/889,033

an SP camera,

an SP audio transmitting device,

an SP audio receiving device,

at least one customer station, wherein the customer station is enabled to be operated by a customer requesting a transaction, wherein the customer station includes therein a customer carrier delivery and receiving device and at least one component of:

a customer visual display,

a customer camera,

a customer audio transmitting device,

a customer audio receiving device,

wherein the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device, and wherein a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device,

a building, wherein the SP station and the customer station are positioned inside of the building.

#### THE REFERENCES

McClure	US 3,294,342	Dec. 27, 1966
Granzow	US 4,580,040	Apr. 1, 1986
Ramachandran	US 5,483,047	Jan. 9, 1996
Gallacher	US 5,661,283	Aug. 26, 1997

Appeal 2007-0699  
Application 08/889,033

## THE REJECTIONS

Claims 1-3, 12, 14-16, 18, 19, and 38-40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McClure and Granzow.

Claims 4-11, 20-23, 28-37, and 41-44 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McClure and Granzow, further in view of Ramachandran.

Claims 13, 17, and 24-27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McClure and Granzow, further in view of Gallacher.

## DISCUSSION

### **McClure and Granzow**

#### **Claim 1**

The Examiner finds that McClure discloses the subject matter of claim 1 except for "the customer station . . . positioned inside of the building." The Examiner finds that Granzow discloses positioning the teller and customer stations inside the building and concludes that it would have been obvious to provide a customer station as taught by McClure inside the building "for a non-driving customer to do banking without waiting line from a drive through ATM" (Answer 5).

Appellants provide 14 pages of arguments as to claim 1 (Br. 14-28). Appellants begin by arguing that McClure lacks more of the recited features and relationships that the rejection admits. In particular, it is argued that

Appeal 2007-0699  
Application 08/889,033

McClure does not teach a device to both deliver and receive the carrier at each of the SP station and the customer station (Br. 17).

This argument is frivolous. McClure is a very short reference, and Appellants are expected to read it. McClure clearly teaches that the customer station has a transmission tube 42 for delivering the capsule 40 (carrier) and a return tube 56 for receiving the carrier (Fig. 3). The teller at the bank station (service provider station) is at the other end of these tubes and can receive and deliver documents. *See* column 2, lines 36-44 (teller and customer connected by two-way television, intercommunication, and pneumatic tubes); column 4, line 34 to column 5, line 64. Thus, McClure expressly teaches a carrier delivery and receiving device at the customer and SP stations, which are operatively connected.

Appellants argue that Granzow does not teach a carrier delivery and receiving device because the transport belts do not require a carrier (Br. 18).

Granzow is applied for only its showing that the customer station of a bank can be located inside a building. Although Granzow is made more relevant because it shows transporting physical things back and forth between the customer and the teller, as in McClure, the rejection does not rely on modifying McClure to have the transport mechanism of Granzow.

As to the sole difference of locating the customer station inside a building, Appellants argue that the rejection is predicated on the walk-up customer not having to wait in line at a drive-through automated teller machine (ATM), but this is not a valid reason because neither McClure nor

Appeal 2007-0699  
Application 08/889,033

Granzow teach or suggest a drive-through ATM and inside banking is not a valid reason because Granzow teaches having long lines inside the building (Br. 20). It is argued that McClure requires that any customer station be kept external of the building and there is no indication that McClure's building is large enough for customer usage, especially customers in their automobiles (Br. 21). Appellants present many other arguments.

The issue is much simpler than Appellants' arguments indicate: Would one of ordinary skill in the banking art have been motivated to locate the customer station in McClure inside a building in view of the teaching in Granzow? The answer is yes. There is nothing different in the operation depending on whether the customer station is inside a building or outside a building (aside from not needed a car), and there is nothing in McClure that indicates the system is limited to the drive-through environment in the preferred embodiment. One of ordinary skill in the art knew that customer stations such as ATMs were often located inside a building where customers walk up indoors, e.g., where the bank is located in a mall, and a reference should not even be required to prove this fact. Nevertheless, Granzow discloses locating a customer station inside a building. One of ordinary skill in the banking art would have been motivated to locate the customer station in McClure inside a building because this was a known location for customer stations as taught by Granzow and because location is a matter of design choice which provides no different results. Also, Granzow teaches a retrieving and delivering device for exchanging documents between a

Appeal 2007-0699  
Application 08/889,033

customer station and an SP station within the building, which suggests doing the same for McClure. That is, to the extent it could be argued that it would not have been obvious to use McClure's pneumatic system in a building because banking in a building is done face to face without the need for such a system, Granzow clearly teaches a device for transferring documents between stations in a building. The rejection of claim 1 is affirmed.

Appellants' many arguments have each been considered in making our decision, but none are deemed persuasive. It is not required that we address each argument. Appellants' numerous arguments seem designed to overwhelm rather than persuade. For example, Appellants argue that the alleged combination would not have resulted in the recited system (Br. 25-27). However, Appellants do not show why putting McClure's customer station inside a building—the only proposed modification—would not have resulted in the claimed invention. As another example, Appellants argue that the rejection is silent as to how the dissimilar components of McClure and Granzow could be connected, and the pneumatic tube of McClure and the belts of Granzow are incompatible (Br. 22). However, this is not the proposed modification. Appellants have made many arguments that have nothing to do with the proposed rejection.

### **Claim 38**

Claim 38 is narrower than claim 1 because it requires a visual display *and* a camera *and* an audio transmitting device *and* an audio receiving device for both the service provider (SP) and customer station, whereas

Appeal 2007-0699  
Application 08/889,033

claim 1 only requires at least one of these components at each station, and claim 38 recites a "*pneumatic tube* carrier delivery and receiving device" at the SP and customer stations, whereas claim 1 only requires a "carrier delivery and receiving device." McClure teaches all of these limitations.

Claim 38 recites that at least one component of the customer visual display, customer camera, customer audio transmitting device, customer audio transmitting device, and customer carrier device "is positioned within the interior area in supporting connection with the interior wall." McClure teaches mounting components on a wall, albeit an exterior wall.

The Examiner's rejection is the same as for claim 1, i.e., that it would have been obvious to locate the customer station of McClure inside a building in view of Granzow. The rejection of claim 38 is affirmed for the reasons stated with respect to claim 1.

## **Claim 2**

Claim 2 depends on claim 38 and recites that "the customer station is positioned within the interior area of the building."

Appellants argue that the ATM in Granzow is located close to the teller and would not need a camera, audio transmitting device, and audio receiving device (Br. 32).

This argument is not persuasive because the Examiner only relies on Granzow for positioning the customer station inside a building. The rejection of claims 1 and 38 is based on positioning the customer station inside the

Appeal 2007-0699  
Application 08/889,033

building, so the rejection of claim 2 is affirmed for the reasons discussed with respect to claims 1 and 38.

### **Claim 3**

Claim 3 recites "a plurality of customer stations are positioned within the interior area of the building."

Appellants argue that the references do not suggest a "lone" customer station within a building and cannot suggest a plurality of customer stations inside the same building (Br. 33).

McClure discloses that "it may be desirable to provide a plural arrangement of such customer stations" (col. 6, ll. 21-23). Because it would have been obvious to locate a customer station within a building in view of Granzow, it further would have been obvious to locate a plurality of customer stations within a building. The rejection of claim 3 is affirmed.

### **Claim 12**

Claim 12 depends on claim 38 and recites "a plurality of customer stations" and the SP station has a communication selector device to select audio and video connection with one of the customer stations.

Appellants argue that neither limitation is taught (Br. 33). The Examiner finds that switches 60 and 60' in Figure 5 of McClure establish operative connection between the SP camera and the customer station (Answer 5).

Appeal 2007-0699  
Application 08/889,033

As discussed in connection with claim 3, it would have been obvious to provide a plurality of customer stations in view of the express teachings of McClure. It is noted that claim 12 does not require all customer stations to be inside the building, but since it would have been obvious to locate a customer station within a building in view of Granzow, it would have been obvious to locate a plurality of customer stations within a building.

The "communication selector device" does not require more than a device to establish audio and video connection between the SP station and one of the customer stations, i.e., it does not require selecting from several customer stations. Claim 12 does not require a plurality of customer stations and a single SP station: there can be a plurality of customer stations and a plurality of SP stations, where the video and audio connection is between one of the SP stations (the one recited in claim 38) and one of the customer stations. McClure discloses "[s]uitable controls" (col. 3, line 56) for the service station, which reasonably suggests a switch (e.g., an ON/OFF switch) to selectively establish communication with the customer.

For these reasons, the rejection of claim 12 is affirmed.

#### **Claim 14**

Claim 14 depends on claim 38 and recites a video switching device "operative to selectively establish video connections between the SP CCTV camera and the customer video display on the customer station." Appellants argue that there is no evidence that device 60 in McClure has the capability of video "switching" (Br. 33-34).

McClure discloses "[s]uitable controls" (col. 3, line 56) for the service station, which reasonably suggests some switch (e.g., the ubiquitous ON/OFF switch) to selectively establish communication with the customer via the SP camera and the customer display only when a customer is present. It would have been within the level of one of ordinary skill in the art not to continuously display the teller to the customer station when there is no customer present. The rejection of claim 14 is affirmed.

### **Claims 15 and 16**

Claim 15 depends on claim 14 and recites a "video material presenting device . . . operative to generate video signals" whereby the "video switching device is operative to selectively connect the video material presenting device to the customer visual display." The Examiner reads video material presenting device on the camera 30 at the teller station (Answer 5).

Appellants argue that the SP camera 30 cannot be the video material presenting device because claim 38 already recites an SP camera and "[h]ow can the sole SP camera (30) be both the recited SP camera and the recited video material presenting device?" (Br. 34).

It would have been more helpful if Appellants had actually said what their video material presenting device is. We find that the specification discloses presenting promotional and other material during portions of the transaction (Specification 20, lines 9-17; Figure 12, element 50). McClure does not disclose a video material presenting device because it does not say anything is displayed on the display other than the camera information. We

Appeal 2007-0699  
Application 08/889,033

agree with Appellants that the camera cannot be the video material presenting device and the camera. The rejection of claim 15 and its dependent claim 16 is reversed.

### **Claim 18**

Claim 18 depends on claims 2/38 (i.e., it depends on claim 2 which depends on claim 38) and recites "the building includes a secure room, and wherein the SP station is housed in the secure room, and wherein the customer station is disposed outside of the secure room." McClure expressly teaches these limitations. Appellants argue that the references do not teach both a customer station and an SP station positioned inside the same building, but this is a limitation of claim 38, which has been previously addressed. The rejection of claim 18 is affirmed.

### **Claim 19**

Claim 19 depends on claims 18/2/38 and recites "a plurality of customer stations in the building, wherein each of the customer stations being in operative connection with the SP station." McClure discloses that there may be a plurality of customer stations, with a corresponding number of operator stations (col. 6, lines 21-24), which together with Granzow's teaching of locating customer stations inside a building, would have motivated one skilled in the art to provide a plurality of customer stations inside a building. However, McClure discloses that the plurality of customer stations have a corresponding number of operator stations, one operator

Appeal 2007-0699  
Application 08/889,033

station for each customer station, thus, there is no teaching of a plurality of customer stations in operative connection with one SP station. The rejection of claim 19 is reversed.

### **Claim 39**

Claim 39 depends on claim 38 and recites "a plurality of customer pneumatic tube carrier delivery and receiving devices are positioned within the interior area of the building." Again, McClure discloses that there may be a plurality of customer stations (col. 6, lines 21-23) and since it would have been obvious to locate a customer station within a building in view of Granzow, it would have been obvious to locate a plurality of customer stations within a building where each customer station includes a pneumatic tube carrier delivery and receiving device. The rejection of claim 39 is affirmed.

### **Claim 40**

Claim 40 depends on claims 39/38 and recites "a plurality of customer stations are positioned within the interior area of the building" wherein each customer station is in operative connection with the SP station. The rejection of claim 40 is reversed for the reasons discussed with respect to claim 19.

**McClure, Granzow, and Ramachandran**

**Claim 4**

Ramachandran is assigned to InterBold, a joint venture between Diebold, the assignee of this application, and IBM Corporation. Ramachandran discloses freestanding ("lobby") and "through-the-wall" ATMs (e.g., col. 1, lines 24-37; col. 2, lines 41-43). A "through-the-wall" ATM has the ATM unit inside the wall of a bank with the customer interface extending through the wall of the bank (col. 1, lines 25-31). Components are mounted in an assembly 40 (corresponding to a "frame") on trays 46 designed to be pulled out and serviced from the front or the rear. A fascia 18 (corresponding to a "cover") for a front load lobby ATM is pivotally mounted to assembly 40 for movement between a first position where components are manually accessible through openings in the fascia and a second position where the components are accessible for servicing. Fascia 50 for a rear load through-the-wall ATM is designed to be permanently affixed to the assembly 40. *See, e.g.*, Figures 2, 4, and 6; col. 5, lines 12-61. The fascia has openings for a keyboard 20, a monitor screen 22, a card accepting slot 24, a receipt delivery opening, a cash delivery door 28, and deposit accepting opening (col. 4, lines 43-53). "Of course, the fascia panel may have other openings and/or components accessible therethrough, such as a camera or a supply of depository envelopes." (Col. 4, lines 53-55.)

The Examiner concluded that it would have been obvious to incorporate the teachings of Ramachandran in the combined transaction system of McClure and Granzow for a through-the-wall installation.

Appellants argue that Ramachandran does not disclose a customer station frame in supporting connection with an interior wall and extending in an opening of the wall, nor a customer station component in supporting connection with the frame (Br. 38).

McClure discloses that the components are mounted to some structure in the wall, but does not disclose the specifics of the structure. Granzow teaches that the wall can be inside a building. The assembly 40 in Ramachandran is a frame, at least as broadly recited, that extends through an opening in the wall in a "through-the-wall" embodiment and is covered by a fascia. The components are mounted to trays 46 which are connected and supported by the assembly 40. One of ordinary skill in the art would have been motivated to mount the components of McClure using the known arrangement in Ramachandran for the advantages thereof, e.g., security, ease of access, etc., and because it is a known way of mounting components for a banking customer station. Nothing in Ramachandran suggests that the wall of the bank must be an exterior building wall. Banks located in indoor malls have the exterior wall of the bank within the building for walk-up customers. Nevertheless, the rejection is based on obviousness and Granzow teaches an interior customer station. The rejection of claim 4 is affirmed.

### **Claim 5**

Claim 5 depends on claims 4/38 and recites that "the customer station further comprises a cover, and wherein the cover is movably mounted on the frame, and wherein the cover is movable to enable access to the opening."

Appellants argue that the cover 18 in Ramachandran is not movably mounted on and supported by a frame/wall (Br. 38-39).

Ramachandran discloses that the fascia 50 for a rear load "through-the-wall" ATM is permanently affixed to the assembly 40 (col. 5, lines 37-44). However, Ramachandran discloses that the freestanding "lobby" ATM can have a fascia 18 pivotally connected to the assembly 40 (corresponding to the "frame"), where in one position the fascia covers the opening in the assembly 40 but leaves openings for manual access to the components, such as the display and keyboard, (e.g., Fig. 4) and in a second position it is disposed away from the wall opening to make the components accessible for servicing (col. 5, lines 45-48). One of ordinary skill in the art of designing ATMs would have appreciated that the pivotal fascia 18 for freestanding ATMs could be used with through-the-wall ATMs since they are mounted to the same assembly, depending on whether a front load or rear load ATM was desired. Accordingly, it would have been obvious to use the pivotal cover in Ramachandran to cover the opening in the wall which accepts the assembly 40. The rejection of claim 5 is affirmed.

### **Claim 6**

Claim 6 depends on claim 38 and recites a cover movably mounted in supporting connection with the wall wherein the components are manually accessible through an opening when the cover is in a first position and the components are rendered accessible for servicing when the cover is in a second position. The rejection of claim 6 is affirmed for the reasons stated in the analysis of claim 5.

### **Claims 7 and 8**

Claim 7 depends on claims 4/38 and recites "wherein the frame comprises a door frame." This claim more specifically limits the frame to a door frame as shown in Appellants' Figures 2 and 5-7. A door is interpreted to be an opening that extends from the ground to some height, as opposed to an opening in the wall. We do not find this teaching of a frame comprising a door frame, nor are we aware that this is a known technique for mounting ATMs. The rejection of claim 7 and its dependent claim 8 is reversed.

### **Claim 9**

Claim 9 depends on claims 4/38 and recites that the frame bounds the opening, and further comprises a subframe wherein one of the customer visual display, camera, or carrier device is supported by the subframe.

Appellants argue that the elements of Ramachandran are part of a freestanding ATM, which is supported by the floor and not a wall.

These arguments fail to fairly address the overall teachings of Ramachandran. The assembly 40 in Ramachandran is a frame that bounds the opening, as broadly claimed, in the "through-the-wall" embodiment. Various portions of assembly 40 shown in Figure 5 can be considered a subframe, such as the bottom wall 44, the dividing wall 42, and the tray 46. Ramachandran discloses support of a customer display and a camera, but we also conclude that one of ordinary skill in the art would have been motivated to mount all of the customer components disclosed in McClure using the arrangement in Ramachandran for its known advantages, i.e., security, accessibility, etc., and because it was a known mounting structure in the art. The rejection of claim 9 is affirmed.

#### **Claim 10**

Claim 10 depends on claims 6/38 and recites that the cover includes a "generally horizontally extending shelf, whereby a customer is enabled to conduct writing or other activities on the shelf."

Appellants argue that Ramachandran does not disclose a shelf and that the tray 46 relied upon by the Examiner is an internal tray which is only extended during servicing and, therefore, not a customer shelf (Br. 41).

While we agree that tray 46 is not a shelf, the fascia example at the lower right in Figure 4 of Ramachandran discloses a flat portion at the bottom which can be considered a shelf. It would have been obvious to use any of the features of the fascias for its known purpose. Granzow also discloses providing a flat writing surface for customers and it further would

Appeal 2007-0699  
Application 08/889,033

have been obvious to provide such a flat surface on a customer station as a minor convenience feature. The rejection of claim 10 is affirmed.

### **Claim 11**

Claim 11 depends on claims 6/38 and recites that "the cover includes at least one storage location, wherein articles are enabled to be stored in the storage location."

Appellants argue that the rejection states that element 28 is a storage location, but the element is actually a cash delivery door (Br. 42).

This argument ignores other relevant teachings. Ramachandran discloses that "the fascia panel may have other openings and/or components accessible therethrough, such as . . . a supply of depository envelopes" (col. 4, lines 53-55.) If there is a supply of envelopes in the fascia (cover), there must be a storage location. The rejection of claim 11 is affirmed.

### **Claim 20**

Claim 20 depends on claim 38 and recites that the customer station is produced by "producing an opening in the wall, positioning a frame in the opening in supporting connection with the wall, and positioning the at least one component in supporting connection with the frame."

Appellants argue that the references do not suggest these limitations, do not teach a customer station frame in supporting connection with an interior wall, and do not suggest a customer station component in supporting connection with the frame (Br. 42).

Appeal 2007-0699  
Application 08/889,033

As discussed in connection with claim 4, the assembly 40 in Ramachandran is a frame in an opening in a wall for a through-the-wall ATM. The assembly 40 has to be supported somehow by the wall. The components are supported by the assembly 40. One skilled in the art would have been motivated to mount the components in McClure in the through-the-wall arrangement taught by Ramachandran for the known advantages. The rejection of claim 20 is affirmed.

### **Claim 21**

Claim 21 depends on claims 20/38 and recites movably mounting the cover in supporting connection to the wall, "wherein the cover is movable between a first position overlying the opening and a second position wherein the cover is disposed from the opening."

We refer to our discussion of Ramachandran in connection with claims 5 and 6. The rejection of claim 21 is affirmed.

### **Claim 22**

Claim 22 depends on claims 21/20/38 and recites "operatively connecting the cover to the frame through a hinge."

Appellants argue that the references do not suggest a movably mounted customer station cover connected to a frame (in an interior wall) through a hinge (Br. 43).

Although Ramachandran describes using a fixed fascia with a through-the-wall ATM, as discussed in connection with claim 5, one of

Appeal 2007-0699  
Application 08/889,033

ordinary skill in the design of ATMs would have appreciated that the pivotal fascia 18 for freestanding lobby ATMs could be used with through-the-wall ATMs since they are mounted to the same assembly 40, depending on whether a front load or rear load was desired. Thus, it would have been obvious to use the hinged cover in Ramachandran to cover the opening in the wall containing assembly 40. The interior wall limitation is discussed in connection with claim 38. The rejection of claim 22 is affirmed.

### **Claim 23**

Claim 23 depends on claims 21/20/38 and recites that "the cover is in abutting relationship with the wall and generally extends in surrounding relation of the frame."

Appellants argue that, as previously discussed, element 18 in Ramachandran cannot be the cover and element 14 cannot be the frame and element 18 isn't even near a wall, let alone an interior wall (Br. 43).

As discussed in connection with claim 5, one of ordinary skill in the art of designing ATMs would have appreciated that the pivotal fascia 18 for freestanding lobby ATMs could be used with through-the-wall ATMs since they are mounted to the same assembly 40, depending on whether a front load or rear load ATM was desired, and that such a cover would abut the wall and surround the frame. Accordingly, it would have been obvious to use the pivotal cover in Ramachandran to cover the opening in the wall which supports the assembly 40. The rejection of claim 23 is affirmed.

Appeal 2007-0699  
Application 08/889,033

### **Claim 28**

Claims 28-37 are directed generally to the structure for the customer station without many of the component limitations. Ramachandran is the most relevant reference for these claims. McClure and Granzow are relied on for the components and locating a customer station inside a building.

Ramachandran is discussed in the rejection of claims 4 and 5. The assembly 40 which holds the components is a "frame" extending through a wall opening and supported by the wall in a through-the-wall ATM. A fascia covers the wall opening and the assembly 40 and is a "cover." One of ordinary skill in the art would have been motivated to mount the components of McClure using the known arrangement in Ramachandran for the advantages thereof, e.g., security, ease of access, etc., and because it is a known way of mounting components for a banking customer station.

Appellants argue Ramachandran teaches that "through-the-wall" ATMs are specifically designed to be at the exterior wall of a bank to enable walk-up or drive-up customers to conduct their transactions without entering the bank, so Ramachandran's "through-the-wall" ATM teaches against the customer station being interior to the building (Br. 44-45).

Nothing in Ramachandran suggests that the wall of the bank must be an exterior building wall. Banks located inside malls, for example, have the exterior wall of the bank within the mall building. Nevertheless, the rejection is based on obviousness and Granzow specifically teaches that a

Appeal 2007-0699  
Application 08/889,033

customer station can be inside the building. There is no difference in structure or operation from locating the customer station on an interior wall.

Appellants argue that Ramachandran teaches that a freestanding ATM is much easier to install than a "through-the-wall" ATM and therefore "one skilled in the art would not have even attempted to install a 'through-the-wall' ATM on an interior wall of a building" (Br. 45).

None of the reasons why freestanding ATMS are easier to install have anything to do with exterior versus interior walls. A "through-the-wall" ATM can be installed in any kind of wall.

Appellants argue that element 18 in Ramachandran cannot constitute a cover, nor can elements 14 and 16 constitute a frame because these elements are all part of a freestanding ATM which is not supported by a wall (Br. 45).

One skilled in the art would have recognized that "through-the-wall" and freestanding ATMs have similar components. One skilled in the art would also have known that the components are mounted to an assembly 40 which must extend through and be supported by a wall in a through-the-wall ATM although the wall and the mounting are not expressly illustrated. It is not necessary for Ramachandran to disclose details that would be immediately evident to one of ordinary skill in the art. As discussed in connection with claim 5, one of ordinary skill in the art of designing ATMs would have appreciated that the pivotal fascia 18 for freestanding ATMs could be used with through-the-wall ATMs if a front load through-the-wall ATM was desired. The rejection of claim 28 is affirmed.

### **Claim 29**

Claim 29 depends on claim 28 and recites "releasably mounting the [customer station] cover in supporting connection with the wall."

Appellants argue that this limitation is not taught (Br. 46).

As discussed in connection with claims 5 and 28, it would have been obvious to use a pivoting fascia in a through-the-wall ATM arrangement if it was desired to have a front load ATM, where such fascia would be releasably mounted to the assembly 40 just as with a freestanding ATM. The fascia in Ramachandran is pivotally mounted by lifting arms to the assembly 40 which is in the wall (e.g., col. 5, lines 12-54; Figs. 2 & 4) and has a locking mechanism (col. 6, lines 23-27) for releasably locking the cover, which meets the limitations of claim 29. The rejection of claim 29 is affirmed.

### **Claim 30**

Claim 30 depends on claim 28 and recites "movably mounting the cover in connection with the wall through a hinge connection, wherein the cover is movable between a first position overlying the wall opening and a second position wherein the cover is disposed from the wall opening."

Appellants refer to their arguments with respect to claims 8 and 22 (Br. 46). Claim 8 is to a different limitation. The arguments with respect to claim 22 are not persuasive as discussed in the analysis of claim 22.

Ramachandran teaches a first position wherein the fascia covers the opening in the assembly 40 (e.g., Fig. 4) and a second position where it is

Appeal 2007-0699  
Application 08/889,033

disposed away from the wall opening (Fig. 2) for a freestanding ATM. As discussed in connection with claim 5, it would have been obvious to use a pivoting fascia 18 in a through-the-wall ATM arrangement if it was desired to have a front load ATM. The rejection of claim 30 is affirmed.

### **Claim 31**

Claim 31 depends on claims 30/28 and recites "releasibly locking the cover in the first position."

Appellants merely say that the limitation is not taught (Br. 47).

As discussed in connection with claim 29, it would have been obvious to provide a through-the-wall ATM in Ramachandran with a pivotal fascia 17 which is releasibly locked if it was desired to have a front load ATM. The rejection of claim 31 is affirmed.

As an aside, we note that claim 31 appears to be an impermissible hybrid claim. Claim 28 is said to be a product-by-process claim. Claim 31 is a method of using the product, not a further limitation on how the product is made, and creates a problem. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (claim directed to system and method for using that system is indefinite).

### **Claim 32**

Claim 32 depends on claims 31/30/28 and recites that "when the cover is moved to the first position the cover extends in generally abutting relation with the wall and in surrounding relation of the frame."

Appellants argue that element 18 in Ramachandran cannot be a cover and element 14 cannot be a frame because it isn't near a wall, nor does Figure 1 show element 18 surrounding the alleged frame 14 (Br. 47).

As discussed in connection with claims 28 and 29, it would have been obvious to provide a through-the-wall ATM in Ramachandran with a pivotal fascia 18 which is releasably locked if it was desired to have a front load ATM. The fascia in a through-the-wall ATM is in abutting relation with the wall and in surrounding relation to the frame (assembly 40). The rejection of claim 32 is affirmed.

### **Claim 33**

Claim 33 depends on claim 28 and recites "wherein step (b) comprises framing the opening with an opening bounding frame, and step (c) comprises positioning the transaction component in supporting connection with the bounding frame."

Although Ramachandran does not illustrate the assembly 40 installed in the wall, one of ordinary skill in the art would understand that the assembly 40 extends through the wall and is covered by a fascia as in Figure 4. The assembly 40 bounds the opening when mounted in a through-the-wall configuration. The components are mounted to assembly 40 (e.g., Figure 6 shows the components mounted in a freestanding ATM in which the assembly 40 fits on top of a base, but a "through-the-wall" would be the same without the base). The rejection of claim 33 is affirmed.

### **Claim 34**

Claim 34 depends on claims 33/28 and recites "step (b) further comprises supporting a subframe in supporting connection with the bounding frame, and wherein step (c) comprises positioning the transaction component in supporting connection with the subframe."

Appellants refer to their arguments for claim 9, which basically say that elements of Ramachandran are part of a freestanding ATM, which is supported by the floor and not a wall.

These arguments fail to fairly address the overall teachings of Ramachandran. The assembly 40 in Ramachandran is considered to correspond to the "frame in the wall opening in supporting connection with the wall" as recited in claim 28 in the "through-the-wall" configuration. Various portions of assembly 40 shown in Figure 5 can be considered a subframe, such as the bottom wall 44, the dividing wall 42, and the tray 46. The rejection of claim 34 is affirmed.

### **Claims 35 and 36**

Claim 35 depends on claim 33 and recites "wherein the bounding frame comprises a door frame, wherein the opening is framed by the door frame." This claim more specifically limits the frame to a door frame as shown in Appellants' Figures 2 and 5-7. A door is interpreted to be an opening that extends from the ground to some height, as opposed to an opening in the wall. We do not find this teaching of a bounding frame comprising a door frame, nor are we aware that this is a known technique for

Appeal 2007-0699  
Application 08/889,033

mounting ATMs. Accordingly, the rejection of claim 35 and its dependent claim 36 is reversed.

### **Claim 37**

Claim 37 depends on claim 28 and recites that "the transaction component is either a visual display, a customer CCTV camera, a customer audio transmitting device, a customer audio receiving device or a customer carrier device."

Appellants argue that the references do not teach or suggest a customer station frame positioned in an interior wall opening and at least one transaction component from the recited list (Br. 49).

We concluded that it would have been obvious for the assembly 40 in Ramachandran to be mounted in an interior wall in the analysis of claim 28. Ramachandran discloses that the components may include a monitor screen 22, corresponding to the claimed visual display, and a camera, which corresponds to the claims customer CCTV camera (col. 4, lines 51 & 55-56). In addition, McClure teaches all of the components. Therefore, the rejection of claim 37 is affirmed.

### **Claim 41**

Independent claim 41 recites a customer station having a frame in supporting connection with an interior wall and a component in supporting connection with the frame. The component only has to be one of a visual

Appeal 2007-0699  
Application 08/889,033

display, a camera, an audio transmitting device, an audio receiving device, and a carrier delivery and receiving device.

As discussed in connection with claims 1 and 38, McClure discloses a customer station having all of the components (although claim 41 requires only one) and it would have been obvious to locate the customer station in an interior area in view of the teachings of Granzow. As discussed in connection with claim 28, Ramachandran discloses a "through-the-wall" ATM where the assembly 40, which corresponds to a frame, fits in an opening in the wall and is in supporting connection with the wall. The assembly 40 is covered with a fascia (e.g., Figure 4).

Appellants argue that Ramachandran's "through-the-wall" ATMs are designed to be at the exterior wall of a bank, and Ramachandran does not suggest a customer station installed on an interior wall (Br. 50).

These arguments have been addressed in the discussion of claim 28.

Appellants argue that even if it were somehow possible to modify McClure/Granzow with the teachings of Ramachandran, the result would still not have produced the recited invention (Br. 50).

This argument does not say what element or function would be missing from the combination.

The rejection of claim 41 is affirmed.

### **Claim 42**

Claim 42 depends on claim 41 and requires a plurality of customer stations as recited in claim 41. McClure discloses that a plurality of

Appeal 2007-0699  
Application 08/889,033

customer stations can be provided (col. 6, lines 20-25). It would have been obvious to locate one or a plurality of customer stations in connection with an interior wall of the building given the teachings of Granzow. The rejection of claim 42 is affirmed.

### **Claim 43**

Independent claim 43 recites a customer station having at least one component of: a visual display, a camera, an audio transmitting device, an audio receiving device, and a carrier delivery and receiving device. The component is in supporting connection with the wall, but the wall does not have to be an interior wall. The customer station has a cover having an opening, wherein in a first position of the cover the component is manually accessible through the opening and in a second position the component is rendered accessible for servicing.

Claim 43 is a broader version of claim 6, which depends on claim 38. Claim 38 recites an SP station and a customer station having all the listed components in the interior area of a building, whereas claim 43 only requires a customer station with one component. Claim 6 recites essentially the same cover limitations as claim 43. The rejection of claim 43 is affirmed for the reasons stated in the analysis of claims 1, 38, and 4-6, which also discusses Appellants' arguments.

### **Claim 44**

Claim 44 depends on claim 43 and recites that "the wall is an interior wall extending in an interior area of the building, wherein the at least one component is positioned within the interior area in supporting connection with the interior wall." The rejection of claim 44 is affirmed for the reasons stated in the analysis of claims 1, 38, and 4-6, in which Granzow discloses that the customer station can be located inside a building.

### **McClure, Granzow, and Gallacher**

#### **Claim 13**

Claim 13 depends on claims 12/38 and recites a sensor "operative to sense a person positioned adjacent the customer station" and an indicator at the SP station "wherein an indication is given at the SP station of the presence of the person adjacent the customer station."

The Examiner finds that Gallacher discloses a sensor at column 4, line 61 to column 5, line 4 (Answer 9-10).

Appellants argue that Gallacher teaches that video communication is terminated after the customer leaves the ATM and does not suggest an indicator that gives an indication of the presence of a person at a customer station (Br. 54).

Gallacher discloses that the ATM may be equipped with proximity sensors to detect the presence of persons (col. 4, lines 10-18; col. 5, lines 2-4). However, there is no description in Gallacher of an "indicator in operative connection with the sensor wherein an indication is given at the SP

station of the presence of the person adjacent the customer station." The sensor is only used to make the request for assistance in the flowchart of Figure 4, and not to provide an indication at the SP station. Thus, the rejection of claim 13 is reversed.

**Claim 17 (and claims 15 and 16)**

Claim 17 depends on claims 16/15/14/38 and recites that the video material presenting device comprises a computer in connection with a data store storing video material and with a data line, "wherein the video material is changeable through the data transmission line."

Gallacher discloses that the customer station display can display either windows generated by a computer (col. 3, lines 38-50) or a video conference with a representative (i.e., video from a camera at an SP station). The windows are considered video material because they are displayed on the same display hardware as the camera video and because "video material" is not defined (e.g., it is not disclosed to be moving images and could be a static image such as ATM menu choices). The computer is a video material presenting device which can change the video material. Thus, Gallacher discloses the limitations of claim 17. Gallacher inherently must have a video switching device to connect either the video material presenting device (the computer) or the SP camera (at the representative), as recited in claims 15 and 16. Thus, in a somewhat rare occurrence, Gallacher cures the deficiencies in the combination of McClure and Granzow as to claims 15 and 16. One of ordinary skill in the computerized banking art would have

Appeal 2007-0699  
Application 08/889,033

been motivated to provide the customer station in McClure with means to switch between video material presenting device or camera output to the customer display in video material presenting device as taught by Gallacher to allow a customer to view video material or the camera output. The rejection of claim 17 is affirmed.

Although we have reversed the rejections of claims 15 and 16, we conclude that Gallacher cures the deficiencies in the combination of McClure and Granzow as to those claims. Accordingly, claims 15 and 16 are rejected under 35 U.S.C. § 103(a) over McClure, Granzow, and Gallacher as discussed above. This is designated a new ground of rejection.

### **Claims 24-27**

Claim 24 depends on claim 38 and recites a plurality of customer stations wherein each customer station includes a "device actuatable by a customer at a customer station," and recites a "queuing device at the SP station . . . wherein the queuing device is operative to generate an order wherein the order includes data representative of a time sequence in which the actuatable devices at the customer stations were actuated, and wherein the queuing device is operative to indicate data responsive to the order."

Appellants' queuing device is described at page 21 of the Specification. A sensor at the customer station provides an indication at the SP station of the customer's presence. The queuing device generates an order for servicing customers based in a time sequence in which customers

Appeal 2007-0699  
Application 08/889,033

arrived at the customer stations, which tells the service provider which customer should be serviced next.

Appellants argue Gallacher does not teach or suggest a queuing device in operative connection with a customer actuatable device of plural customer stations (Br. 55). It is argued that Gallacher teaches against queuing because it is based on random selection (Br. 55). It is argued that the rejection provides no motivation for combining the features of the references to produce Appellants' invention (Br. 55).

The Examiner states that the actuatable device is the card reader which is activated by the customer's card and the queuing device corresponds to computer C in Figure 11 receiving a message (Answer 9).

Gallacher discloses a device actuatable by the customer at a customer station (col. 4, lines 10-18; col. 5, lines 2-4). Gallacher discloses that one prior art way of assigning a representative to a customer in a telephone ordering environment is to put customers in a queue when they make a request (col. 3, lines 13-28). The problem with this approach is said to be that next available representative is assigned to the first person in the queue and that representative may not be the best person to answer the question. Gallacher uses a method where the representative is assigned based on the type of transaction the customer was undertaking (col. 3, lines 30-35). Gallacher still teaches that queuing could be used and queuing inherently generates an order indicative of the time sequence in which requests were received. However, Gallacher does not teach that "the queuing device is

Appeal 2007-0699  
Application 08/889,033

operative to indicate data responsive to the order" since queuing is only mentioned with respect to the prior art. The rejection does not address this limitation. Therefore, we reverse the rejection of claim 24 and claims 25-27 which depend therefrom.

#### NEW GROUNDS OF REJECTION

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) over McClure, Granzow, and Gallacher as discussed in the rejection of claim 17.

For some reason, claims 45-47 were not rejected although they do not materially differ from the rejected claims. We add the following new grounds of rejection.

Claims 45 and 46 are rejected under 35 U.S.C. § 103(a) as unpatentable over McClure, Ramachandran, and Granzow. McClure discloses all of the customer station components (although claims 45 and 46 only require one of the components). Granzow discloses that customer stations can be located inside a building. It would have been obvious to locate the customer station of McClure inside a building in view of Granzow's teaching that this was a known location. McClure does not specifically disclose the structure for mounting the components in the wall. Ramachandran discloses mounting components for a customer station on a frame (assembly 40) in a wall opening in supporting connection with the wall for a through-the-wall configuration. One of ordinary skill in the art would have been motivated to mount the components of McClure on a frame in an opening in a wall as taught by Ramachandran for the known

Appeal 2007-0699  
Application 08/889,033

advantages of such an arrangement, e.g., security, accessibility, etc. As to claim 46, McClure discloses a plurality of customer stations. It would have been obvious to locate the plurality of customer stations inside in view of Granzow to service multiple walk-up customers.

Claim 47 is rejected under 35 U.S.C. § 103(a) as unpatentable over McClure and Granzow. McClure teaches all of the limitations of claim 47 except for the "customer station . . . positioned inside of the building." One of ordinary skill in the art would have been motivated to provide a customer station as taught by McClure inside of a building to serve walk-up customers in view of the teaching in Granzow that customer stations can be inside of a building. The customer station works the same way whether it is used inside or outside, or by drive-up or walk-up customer. Locating the customer station inside a building is discussed throughout this opinion.

## CONCLUSION

The rejections of claims 1-6, 9-12, 14, 17, 18, 20-23, 28-34, 37-39, and 41-44 are affirmed.

The rejections of claims 7, 8, 13, 15, 16, 19, 24-27, 35, 36, and 40 are reversed.

New grounds of rejection are entered as to claims 15, 16, and 45-47.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

Appeal 2007-0699  
Application 08/889,033

Regarding any affirmed rejection, 37 C.F.R. § 41.52(a)(1) provides:

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. . . .

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the Primary Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

Appeal 2007-0699  
Application 08/889,033

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

**AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)**

tdl

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